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08/865,419 05/28/97 AUGER

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EXAMINER

LIOTT, C

ART UNIT

PAPER NUMBER

1751

DATE MAILED:

01/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/865,419

Applicant(s)

Auger

Examiner
Caroline D. Liott

Group Art Unit
1751



☒ Responsive to communication(s) filed on Nov 2, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-10, 20-23, 25, 26, and 29-36 is/are pending in the application.

Of the above, claim(s) 23, 25, 26, and 29 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-10, 20-22, and 30-36 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1751

Applicant's Amendments filed 11/2/00 have been entered except for the amendment to claim 8 because the term "peroxide" does not appear at line 6. Applicant's Remarks filed 11/2/00 have been fully considered.

Applicant is advised that should claims 3 and 9 be found allowable, the claims will be objected to under 37 CFR 1.75 as being substantial duplicates. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Applicant is suggested the cancel one of these claims.

Restriction Requirement

The restriction requirement remains for the reasons set forth in the parent applications. Prosecution is being continued on the invention elected in the prior application, i.e. Group I, which reads on instant claims 1, 3-10 and 31-36. Method claims 2 and 20-22 have also been examined as in the prior application. Claims 23, 25-26 and 29 stand drawn to an invention nonelected with traverse in Paper No. 11.

Claim Rejections

Claims 1 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards

Art Unit: 1751

as the invention. This rejection is maintained primarily for the reasons set forth in the previous Office Action, Paper 31 mailed 8/2/00.

Claim 1 is indefinite because the last five lines of the claim are unclear. Furthermore, it is improper to recite method steps in a kit claim. Clarification is required.

The "base" of claim 31 reads on the "oxygen source" of claim 30 (e.g. sodium hydroxide). A claim in which one ingredient is defined so broadly that it reads upon a second does not meet the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Ferm and Boynton*, 162 USPQ 504 (BdPatApp & Int 1969).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Matsushita Electric Works. This rejection is maintained primarily for the reasons set forth in the previous Office Action, Paper 31 mailed 8/2/00.

Art Unit: 1751

Matsushita Electric Works, JP 60-250,906, teaches and exemplifies a two-component “kit” for imparting a pre-determined bleached color to a wood substrate which comprises an aqueous solution consisting of a cobalt or nickel metal salt, and an aqueous solution consisting of hydrogen peroxide, see page 4, Table and paragraph 1. Matsushita Electric Works, therefore, clearly anticipates kits as claimed. Note that Matsushita’s bleaching kits do not anticipate or obviate “kits for coloring wood substrates” as claimed because bleaching is the opposite of coloring; however, bleaching does result in a “pre-determined color” as currently claimed.

Claims 3-7, 9-10 and 30-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown. This rejection is maintained primarily for the reasons set forth in the previous Office Action, Paper 31 mailed 8/2/00.

Brown, U.S. Patent No. 5,173,085, teaches and exemplifies three-part compositions for dyeing hair wherein the first part comprises an aqueous solution which contains additives (e.g. a surfactant) and a metal salt (e.g. copper sulfate) in the claimed amounts, and the third part comprises a 6% aqueous solution of hydrogen peroxide, see Examples 2-4. Brown, therefore, clearly anticipates the claimed kits.

Claims 3-10 and 30-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Tennigkeit. This rejection is maintained primarily for the reasons set forth in the previous Office Action, Paper 31 mailed 8/2/00.

Tennigkeit, U.S. Patent No. 4,992,077, teaches and exemplifies two-part compositions for dyeing hair wherein the first part comprises water, additives and a metal salt (copper (II) chloride

Art Unit: 1751

or copper sulfate) in the claimed amounts, and the second part contains hydrogen peroxide in the claimed amounts, see Examples 1a-3a and col. 5, lines 22-27. Tennigkeit, therefore, clearly anticipates kits as claimed.

Claims 1, 3-6, 9-10, 30 and 32-36 are rejected under 35 U.S.C. 102(b) as anticipated by Est. Light Ind. Min (herein referred to as Light). This rejection is maintained primarily for the reasons set forth in the previous Office Action, Paper 31 mailed 8/2/00.

Light, SU 499,297 (see English language translation for all citations), teaches processes for treating leather by first treating with a solution which contains hydrogen peroxide and sodium hydroxide (oxygen sources and base) in the claimed amounts, followed by treating with a solution which contains alum (aluminum potassium sulfate) alone or in combination with chromium salts in the claimed amounts, see Example. Light, therefore, clearly anticipates kits as claimed.

Claims 3-7, 30-31 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Yantai University. This rejection is maintained primarily for the reasons set forth in the previous Office Action, Paper 31 mailed 8/2/00.

Yantai University, CN 86-104,010, teaches and exemplifies two compositions which are applied stepwise to marble to impart a color to the marble, wherein the first part is a solution of silver nitrate, and the second part is a solution of water, formaldehyde and sodium hydroxide (oxygen source) as claimed, see provided CAPLUS Abstract. Yantai University, therefore, clearly anticipates kits as claimed.

Art Unit: 1751

Claims 2-8, 9-10, 20-22, 30-34 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Dombay. This rejection is maintained primarily for the reasons set forth in the previous Office Action, Paper 31 mailed 8/2/00.

Dombay, U.S. Patent No. 3,554,785, teaches and exemplifies a process for treating wood (teak) with a kit as claimed in order to obtain a color on the wood, see Example 4. Specifically, the "kit" comprises a solution A which contains the metal salt cupric sulfate in the claimed amounts, as well as an acid (hydrochloric) as claimed, see Example 4. This composition is diluted with water and is first applied to the wood, followed by drying as claimed. The wood is then treated with a second aqueous solution which contains hydrogen peroxide in the claimed amounts, see Example 4 and col. 3, lines 19-25. Dombay teaches that this solution is also suitable for dilution as claimed, see col. 5, lines 56-64. The wood is then treated with a nitrocellulose lacquer (sealant) as claimed. The method takes place at room temperature.

Also note Example 5 wherein wood is treated with a first composition containing potassium permanganate in the claimed amounts, and additives as claimed, wherein the composition is diluted with water as claimed. After drying and treating with a hypochlorite composition, the wood is treated with a solution of hydrogen peroxide as claimed. Dombay, therefore, clearly anticipates wood coloring kits as claimed, and wood coloring methods as claimed.

Art Unit: 1751

Claims 2-8, 9-10, 20-22 and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dombay. This rejection is maintained primarily for the reasons set forth in the previous Office Action, Paper 31 mailed 8/2/00.

Dombay is relied upon as set forth above as teaching and exemplifying wood coloring kits which comprise an aqueous solution of a metal salt, and an aqueous solution of hydrogen peroxide as claimed. Dombay teaches that the peroxide oxidant may be present in the lower claimed proportions (see col. 4, lines 35-38), but does not exemplify a kit which contains the peroxide in such proportions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a kit which comprises a first composition which contains water and a metal salt in the claimed amounts, and a second composition which contains water and hydrogen peroxide in the claimed amounts, wherein each composition is sequentially applied to wood to color the wood, because such kits fall within the scope of those as taught by Dombay.

Claims 2-10, 20-21, 30-31 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Bures. This rejection is maintained primarily for the reasons set forth in the previous Office Action, Paper 31 mailed 8/2/00.

Bures, CS 145,495 (see provided English language translation for all citations) teaches and exemplifies three step processes for treating wood with three aqueous solutions wherein the first solution contains an oxygen source (e.g. hydrogen peroxide) as claimed, and the third solution contains a metal salt (e.g. silver nitrate) and additives (e.g. ammonia) as claimed, see

Art Unit: 1751

Examples 1-3. The solutions are applied at room temperature, and are dried between application steps as claimed. Bures, therefore, anticipates kits and methods as claimed.

Claims 2-10, 20-22 and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bures. This rejection is maintained primarily for the reasons set forth in the previous Office Action, Paper 31 mailed 8/2/00.

Bures is relied upon above as teaching kits and methods for dyeing wood as claimed, particularly wherein the one part/step comprises/applies water and an oxygen source as claimed, and another part/step comprises/applies water, a metal/mineral salt and additives as claimed. The reference teaches that the metal salts and oxygen sources may be present in the aqueous solutions in the claimed amounts, see claim 1. Bures also teaches that the wood may be further treated, such as by application of coatings as claimed, see page 8, lines 3-6. Bures does not appear to exemplify compositions which contain the components in the claimed amounts, and does not exemplify a coating step as claimed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the claimed oxygen sources and metal salts to Bures aqueous compositions in the claimed amounts because Bures teaches such amounts as suitable for the patentee's wood coloring compositions. It also would have been obvious to those skilled in the art to further applying a coat as claimed to Bures colored wood products because Bures specifically teaches that the colored wood products obtained by the patentee's methods may be further treated with such coatings.

Art Unit: 1751

Response to Arguments and Amendments

Applicant's Amendments are deemed persuasive to overcome the claim objections previously of record.

Applicant's Amendments are deemed persuasive to overcome the 35 U.S.C. 112, first paragraph, rejection previously of record.

Applicant's Amendments have overcome some of the 35 U.S.C. 112, second paragraph rejections, the others of which remain for the reasons set forth above.

Applicant's Remarks regarding the above art rejections under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) have been fully considered, but are not deemed persuasive to overcome the rejections for the following reasons.

Regarding the above rejection over Matsushita, Applicant argues that the reference colors wood with dyes and synthetic resins, and therefore teaches away from the invention. This argument is not deemed persuasive because the Example relied upon in Matsushita *contains no dyes or synthetic resins*.

Regarding the above rejection over Brown, Applicant argues that Brown dyes hair, not wood. It is well settled that a mere statement of a new use for an otherwise old or mere obvious composition cannot render a claim to the composition patentable. See *In re Zierden*, 162 USPQ 102, 107. The intended use of the claimed kits is given little, if any, patentable weight. See *In re Albertson*, 141 USPQ 730 (CCPA 1964), and *In re Heck*, 114 USPQ 161 (CCPA 1957).

Art Unit: 1751

Applicant argues that Brown's methods comprise intermediate steps, and that Brown's peroxide bleaches rather than fixing the metal salts. The claimed kits do not exclude Brown's intermediate steps/solutions, and the intended use of the claimed components is also not given patentable weight. Therefore, the rejection over Brown remains.

Regarding Tennigkeit, Applicant again argues that the reference teaches dyeing hair, not wood. Where the claimed and prior art products are identical or substantially identical in composition, a prima facie case of either anticipation or obviousness has been established. See *In re Best*, 195 USPQ 430, 433 (CCPA 1977). "Products of identical chemical composition cannot have mutually exclusive properties." If the prior art teaches the identical composition Applicant is claiming, the properties disclosed or claimed by Applicant are necessarily present. See *In re Spada*, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Applicant has the burden of showing that the prior products differ from those as claimed. See MPEP 2112.01. Because no such evidence of record exists, the rejection over Tennigkeit remains as of record.

Applicant argues that the cases relied upon by the Examiner regarding intended are more than a quarter century old. This is not so, see e.g. *Spada* (Fed. Cir. 1990). Furthermore, the above current MPEP citation shows that such standards are still applicable.

Regarding Light, Applicant again argues that Light treats leather rather than wood. This argument is not deemed persuasive for the reasons explained above. Applicant teaches that Light's multiple steps teach away from the claimed invention. No methods are rejected over

Art Unit: 1751

Light, and method steps cannot be read into the kit claim. For all these reasons, the above rejections remain.

Regarding Yantai, Applicant argues that the reference treats marble, not wood as claimed. This argument is not deemed persuasive for the reasons discussed above.

Regarding the rejections over Dombay, Applicant argues that the references uses methylated spirits, which the present invention particularly avoids. The claims, which recite open claim language, never exclude methylated spirits from the claimed kits and methods. Although such additives may be undesirable, this does not necessarily exclude them from the claims.

Regarding Bures, Applicant argues that the reference does not teach the claimed kits which comprise aqueous solutions being adapted to sequentially penetrate and react to form a color. Bures's first and third compositions read on the claimed kits which comprise first and second aqueous solutions. Bures's compositions are also applied sequentially, and result in a colored wood. Therefore, it is unclear which claim limitations Bures lacks, and the rejection therefore remains.

Nothing on the record proves that the prior art's exemplified kits and methods differ from those as claimed. See MPEP 2112 for a discussion of the Office's treatment and interpretation of product (e.g. kit) and method claims. For all these reasons, the above rejections remain.

ArtUnit: 1751

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Caroline Liott** whose telephone number is (703) 305-3703. The examiner can normally be reached on Mondays-Thursdays from 8:30am to 6:00pm, and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. All official before final faxes should be sent to (703)305-7718. All official after final faxes should be sent to (703)305-3599. All non-official faxes should be sent to (703)305-6078.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0661.

C.D.L.
January 15, 2001

Caroline S. Liott
Caroline S. Liott
Primary Examiner